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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 847_073	
Express Mail Label No. EV 676905042 US	Application Number 10/719,768 Conf. #3283	Filed November 21, 2003	
	First Named Inventor Susanta Datta		
	Art Unit 2834	Examiner Karl I. Tamai	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>42,897</u></p> <p> _____ Signature Joseph M. Milstein, Ph.D. _____ Typed or printed name (315) 425-9000 _____ Telephone number September 22, 2006 _____ Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



EXPRESS MAIL LABEL No. EV676905042US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	10/719,768	Confirmation No.:	3283
Applicant:	Susanta Datta	Filed:	November 21, 2003
Art Unit:	2834	Examiner:	Karl I. Tamai
Docket No.:	847-073	Customer No.:	20874
TITLE:	UNSEALED NON-CORRODING WET WASHDOWN MOTOR		

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

STATEMENT FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

In conjunction with the Notice of Appeal and the Pre-Appeal Brief Request for Review, please consider the Remarks that follow. Applicant believes that no fees are due on account of the submission of this paper, and the fees due for the submission of the Notice of Appeal are being paid concurrently herewith. However, if Applicant is incorrect and fees in a different amount are due, the Director is hereby authorized to charge any additional fees, or to make any refund of an overpayment, to Deposit Account No. 50-0289.

Remarks/Arguments begin on page 2 of this paper.

REMARKS

1. Reason for Pre-Appeal Brief Request for Review

In the rejection of claims 10-12, which was made FINAL, the Examiner did not adequately consider the following limitation present in independent claim 10:

10. A method of washing **an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight**, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components, ...

2. Argument

A. The Examiner admits that he gave a limitation “no patentable weight.”

The Examiner states that “If the prior art structure is capable of performing the intended use, then it meets the claim.” The Examiner argues that “the dish washing machine is used in washing dishes is capable of use in the research, manufacture and distribution of food and drugs subject to FDA oversight.” The Examiner states: “The limitation was not previously and is currently not been given patentable weight.” (Detailed action at page 3)

The specification makes clear, at least at paragraphs [0006]-[0008], [00039]-[00044], and [00049]-[00054] that the apparatus and its use is subject to FDA oversight.

At paragraph [00071] the application recites in relevant part:

We will now describe the operation of the motor and motor assembly according to principles of the invention. ... **After the motor and motor assembly have completed the contemplated operation, such as mixing or stirring material for use in a food processing or medicinal processing operation subject to FDA regulation or oversight**, the motor and motor assembly are removed, as necessary, **from the food or medicine preparation apparatus**. If the motor and motor assembly can be safely cleaned within the food or medicine preparation apparatus, the motor and motor assembly need not be removed, and optionally may be cleaned in place. **The motor and motor assembly are washed down using a washing fluid, for example a water-based cleaning fluid.** (emphasis added)

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It is contrary to MPEP §2111.02 for the Examiner to accord no patentable weight to the limitation “an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight.” At MPEP §2111.02, there is stated:

“If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). ...

PREAMBLE STATEMENTS LIMITING STRUCTURE

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”) ...

PREAMBLE STATEMENTS RECITING PURPOSE OR INTENDED USE

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use “can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. ...

The limitation “**an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight**” gives “life, meaning and vitality to the claim,” is a statement that limits the structure, and is not merely a statement of purpose or intended use. This is clear from “the entirety of the record,” including the Specification itself.

B. None of the references cited teach any apparatus or use subject to FDA oversight.

Applicant argued in the paper submitted on April 10, 2006, at pages 4-7, that the first cited reference, U.S. Patent No. 3,750,951 to Perl relating to dishwashing machines, fails to disclose any apparatus or use of an apparatus that is subject to FDA oversight.

Applicant argued that in the paper submitted on April 10, 2006, at pages 8-9, that the second reference, a non-patent literature publication by Selders, relating to disassembling electric motors and oiling them with SAE motor oil, fails to disclose any apparatus or use of an apparatus that is subject to FDA oversight.

C. The Examiner has used a passage out of context.

Applicant argued in the paper submitted on April 10, 2006, at pages 5-6, that the passage offered by the Examiner as relating to inherently drying the motor of Perl was taken out of context and does not teach what the Examiner would like to suggest it teaches.

D. There is no motivation to combine the references cited.

Applicant argued in the paper submitted on April 10, 2006, at pages 9-10, that the Examiner failed to comply with the requirement to provide a motivation to combine references, and cited case law to support that point.

The Examiner has responded that the motivation to combine comes from Perl and Selders. The Examiner admits that Perl fails to teach “periodically removing the motor to be cleaned.” (Detailed action at page 2)

However, Perl teaches a motor in a dishwasher. It is commonly known by those skilled in the art that a dishwasher motor is usually not removed unless it has failed. Selders teaches a motor that has become dirty, and needs to be disassembled (not removed from anything) to be cleaned. The argument by the Examiner that the motor of Perl is INHERENTLY cleaned in operation is strong motivation NOT to combine the step taught by Selders to disassemble that motor in order to clean it. By the argument presented by the Examiner using the Perl reference alone, the dishwasher motor is already clean.

The Examiner needs to explain why, by his logic, he would then be motivated to extract that dishwasher motor from the dishwasher to clean it again.


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CONCLUSION

Applicant has presented reasons for traversing the Final Rejection of claims 10-12, and has argued that the Rejection should be withdrawn. Applicant submits that claims 10-12 are now in proper condition for allowance, and requests the issuance of a Notice of Allowance at the Examiner's earliest convenience. Please call Applicant's attorney at the phone number noted below if it is believed that any discussion of this matter would be helpful.

Respectfully submitted,
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Date: September 22, 2006

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